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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,714	01/05/2001	David T. Berquist	55350US6B014	5169

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3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER	
BANGACHON, WILLIAM L	

ART UNIT	PAPER NUMBER
2635	18

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/755,714	BERQUIST ET AL.	
	Examiner	Art Unit	
	William Bangachon	2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-19,22-27 and 31-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-19,22-27 and 31-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/9/04 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 4-17, 22-27, and 31-33 has been considered but are moot in view of the new ground(s) of rejection.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: It is unclear in the specification on how the location of an item of interest within the interrogation area, as claimed, is determined.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or

discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Applicant is advised that should claim 17 be found allowable, claim 1 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 4-17, 22-27, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,640,002 (Ruppert et al) in view of USP 4,827,395 (Anders et al).

In claims 1, 17, and 30, Ruppert et al teach of a portable RFID reader (314) for use in interrogating RFID tags (figure 20) associated with items of interest, comprising:

(a) an RFID interrogation source {col. 22, lines 59-65; col. 23, lines 6-10; col. 44, lines 63-67};

(b) an antenna (304, 307, 440) {col. 23, lines 10};

(c) a processor (320);

(d) a display (figures 1 and 13; figures 16 and 19: 308, 328); and

(e) a user interface (328, 308A, 308B)

Ruppert does not disclose "showing on the display an item of interest as a second graphical component relative to the first graphical component indicating a location within the interrogation area". Anders et al, in the same field of endeavor (portable RFID systems), is relied upon to teach such features as shown in figure 29, for the purpose of locating objects within an interrogation area {Anders, col. 36, line 36-61; col. 37, lines 11-26}. Clearly, the graphical depiction of the location of an object within an interrogation area in the display of Anders et al provides a visual representation to a user of where an object may be located. And obviously, the graphical depiction of the location of an object within an interrogation area in the display, as taught by Anders, is desirable in the system of Ruppert because these provides a shopper with a visual depiction on where objects in a grocery store might be, to one of ordinary skill in the art.

In claim 4, the processor and display are components of a hand-held computer (320) {Ruppert, col. 17, lines 29-36}.

In claim 5, the display may be activated by touch {Ruppert, paragraph-bridging cols. 17 and 18; Anders, col. 36, lines 48-61}.

In claim 6, the user interface further includes text associated with the item of interest may be presented on the display for observation by a user as shown in figures 1 and 13 {Ruppert, col. 30, lines 4-32; Anders, col. 36, lines 48-61}.

In claims 7 and 23, Rupert et al does not disclose expressly **"at least one audio signal for providing information to the user related to an interrogated RFID tag"**. Rupert et al teach of mixed shopping for products with both barcodes and RFID tags. When a shopper picks a product off the shelf, the product ID is input in the system either by scanning or interrogation {col. 32, lines 9-20}. If there is a good reading on the scanned product, a audible indication is performed {col. 27, lines 60-64}. Obviously, a visible or audible indication is also performed on an interrogated RFID tag because whether a product is scanned or interrogated, the ID of the product is the input to the system, to one of ordinary skill in the art. Anders teach of "the use of audio signal for providing information to the user related to an interrogated RFID tag" for the purpose of guiding the user to a location of an object {Anders col. 36, line 63-col. 37, line 26}. Obviously, these features are desirable in the system of Ruppert because it adds an additional tool for locating an object, to one of ordinary skill in the art.

In claim 8, "the audio signal is provided each time an RFID tag is interrogated" whether it is a bad read or a good read {Ruppert, col. 27, lines 60-64; Anders, paragraph bridging cols. 36 and 37}.

In claim 9, the portable RFID reader of claim 7, wherein the audio signal is only provided when the RFID tag of an item meeting a predetermined criterion is interrogated {Ruppert, col. 27, lines 60-64; Anders, paragraph bridging cols. 36 and 37}. In this case, a successful decoding operation was performed.

In claim 10, the portable RFID reader of claim 9, wherein the predetermined criterion is selected from a group consisting of

(a) a specific RFID tag associated with an item of interest {Ruppert, col. 22, lines 59-65};

(b) an RFID tag that is out of order relative to the RFID tag of at least one adjacent item; and

(c) a class of items to which the item of interest belongs {Anders, paragraph-bridging cols. 36 and 37}.

In claim 11, the portable RFID reader of claim 10, wherein the criterion in response to which the audio signal is provided may be presented on the display for observation by a user {Ruppert, col. 32, lines 17-20; Anders, paragraph bridging cols. 36 and 37}.

In claims 12 and 24, "at least one light for providing information to the user" {Anders, paragraph bridging cols. 36 and 37},

In claims 13 and 25, clearly, there has to be at least one light that is illuminated each time an RFID tag is interrogated, as a visible indicator {Anders, paragraph bridging cols. 36 and 37}.

In claims 14 and 26-27, the portable RFID reader of claim 12, wherein the light is only illuminated when the RFID tag of an item meeting a predetermined criterion is interrogated {Anders, paragraph-bridging cols. 36 and 37}.

In claim 15, the portable RFID reader of claim 14, wherein the predetermined criterion is selected from a group consisting of

(a) a specific RFID tag associated with an item of interest {col. 22, lines 59-65};

(b) an RFID tag that is out of order relative to the RFID tag of at least one adjacent item; and

(c) a class of items to which the item of interest belongs{Anders, paragraph-bridging cols. 36 and 37}.

In claim 16, the portable RFID reader of claim 15, wherein the criterion in response to which the at least one light is illuminated may be presented on the display for observation by a user {Anders, paragraph bridging cols. 36 and 37}.

Claim 17 recites the combination of claims 1-3 and therefore rejected for the same reasons.

Claim 22 recites the combination of claims 1 and 7-11 and therefore rejected for the same reasons.

Claims 24-25 recites the combination of claims 1 and 13-14 and therefore rejected for the same reasons.

10. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,640,002 (Ruppert et al) in view of USP 4,827,395 (Anders et al), and further in view USP 6,318,636 (Reynolds et al).

In claims 18-19, Ruppert in view of Anders does not disclose expressly the use of bars and icons. Reynolds et al teach of using the display graphics to indicate a bad read from a good read {figures 6 and 7; col. 8, line 63-col. 9, line 20} for the purpose of providing an intuitive output {Reynolds, col. 2, lines 48-50; col. 9, lines 21-33}. Clearly, these features are desirable in the system of Ruppert to indicate a bad read from a bad read. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have used the display graphics to indicate the location of an item of interest wherein claim 18 uses bars and claim 19 uses icons, in the system of Ruppert, as taught by Reynolds, because this will distinguish a bad read from a good read.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 5,294,781 (Takahashi et al) is cited in that it teaches of displaying a location of a shopper in relation to an object of interest {see whole document}.

Examiner Contact Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

William L Bangachon
Examiner
Art Unit 2635

June 27, 2004